

REMARKS

This Response is submitted in reply to the Office Action dated January 23, 2006. Claims 1, 15, 20, 25, 31, 36, 43, 46, 47, 52, 57, 64, 69 and 70 are currently amended. Claim 21 is cancelled without prejudice or disclaimer. The specification is also amended. No new matter has been added by any of these amendments.

A Petition for a One Month Extension of Time to file this Response and a Supplemental Information Disclosure Statement are submitted herewith. Please charge deposit account number 02-1818 for any fees which are due and owing in connection with this Response and Supplemental IDS.

The Examiner has not initialed that he considered EP 0926645 on the PTO Form 1449 considered by the Examiner on January 7, 2006. Applicants respectfully request the Examiner to consider this reference in connection with this application. If the Examiner requires another copy of this reference, Applicants respectfully request that the Examiner contact the undersigned.

The Office Action rejected Claims 1 to 13, 15 to 29, 31 to 41, 43 to 50, 52 to 62 and 64 to 78 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,312,334 to Yoseloff in view of Let's Make a Deal – Wikipedia ("LMD").

Yoseloff discloses a gaming device that entices players to risk an initial award in return for the opportunity to receive a greater payoff in a second game segment during which a player chooses from several masked awards. For example, the player risks prizes obtained from a first game or event in the second game or the second event. In the second game, a player selects one of three doors to receive a prize, a neutral event (e.g., a push, loss of a percentage of the wager, gain of a small percentage of the wager, etc.) or a doubling or otherwise substantial increase in the wager award. The outcome associated with the selected door is provided to the player. Yoseloff does not disclose a first potential award offer formed from a first number of first values (wherein the first number is greater than one) and a second potential award offer formed from a second number of second values. Moreover, Yoseloff does not disclose that the first number is, on average, greater than the second number, and the second values are, on average, greater than the first values.

LMD provides a description of a game show wherein a player may keep a known prize or trade the awarded prize for one of a number of unknown awards which are hidden from view. As stated in the Office Action, during the game show, a contestant is offered multiple award offers, wherein the contestant is given several chances to trade in the award item in exchange for another item. The contestant is allowed to keep their winnings or give up everything already won for a spot in the Big Deal of the Day. The Big Deal of the Day allows the player to receive an award, which is greater or less in value than the initial offer. LMD does not disclose a first potential award offer formed from a first number of first values (wherein the first number is greater than one) and a second potential award offer formed from a second number of second values. Moreover, LMD does not disclose that the first number is, on average, greater than the second number, and the second values are, on average, greater than the first values

Applicants respectfully submit that neither Yoseloff nor LMD individually, nor the gaming device resulting from the combination of Yoseloff and LMD disclose, teach or suggest determining the greatest/highest of the potential award offers and offering the determined greatest/highest of the potential award offers to the player as an initial offer. That is, while the prize award in one of the doors of Yoseloff may be greater than the prize award of another door, neither Yoseloff (nor LMD) disclose, teach or suggest determining which of the prize awards is greater and only offering the determined greater prize award to the player. On the other hand, the gaming devices of amended independent Claims 1, 20, 46 and 57 each generally include determining the greatest/highest of the potential award offers and offering the determined greatest/highest of the potential award offers to the player as an initial offer.

Additionally, the Office Action states that it is well known in the art to offer awards with different numbers of values selected from a range of numbers having a greater upper end than a second range of numbers employed to select the number of values used to form another award offer, in order to provide a plurality of award outcomes. The Office Action further states that this is an important aspect of casino management used to control the odds in which awards or other features are present. The Office Action concludes that it would have been obvious to one skilled in the art at the time the

invention was made to modify Yoseloff's gaming device and have awards selected from a range of numbers having a greater upper end than another range of numbers in order to offer the possibility to win from a wide range of awards, and control the odds of the awards.

Applicants respectfully disagree. Applicants submit that obviousness cannot be established by combining the prior art to produce the claimed invention absent some case law on teaching, motivation or suggestion supporting the combination. MPEP §2143.01; *In re Lee*, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002). The Patent Office must show the "reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art" and combine those elements in the same manner as the claimed invention. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998).

In this case, the Office Action relies on Yoseloff's disclosure of offering different types of wagering games to conclude that a gaming device resulting from the combination of Yoseloff and LMD includes at least two potential award offers wherein a first potential award offer is formed from a first number of first values and a second potential award offer is formed from a second number of second values, wherein the first number is, on average, greater than the second number, and the second values are, on average, greater than the first values. Applicants respectfully disagree with this conclusion and submit that neither Yoseloff nor LMD individually, nor the gaming device resulting from the combination of Yoseloff and LMD teach, disclose or suggest a first potential award offer formed from a first number of first values (wherein the first number is greater than one) and a second potential award offer formed from a second number of second values. Moreover, neither Yoseloff nor LMD individually, nor the gaming device resulting from the combination of Yoseloff and LMD teach, disclose or suggest that the first number is, on average, greater than the second number, and the second values are, on average, greater than the first values. Accordingly, for these reasons, Applicants respectfully submit that amended independent Claims 1, 20, 36 and 69 are patentably distinguished over Yoseloff and LMD and in condition for allowance.

Claims 2 to 13, 15 to 19, 22 to 29, 31 to 35, 37 to 41 and 43 to 45 depend directly or indirectly from Claims 1, 20 and 36, respectively, and are also allowable for the reasons given with respect to Claims 1, 20 and 36, and because of the additional features recited in these claims.

Amended independent Claim 46 is directed to a gaming device including, amongst other elements, at least two potential award offers each adapted to be formed from a plurality of values displayed to a player, wherein the potential offers and the third offer are each totals that are predetermined before the display of the values, and wherein the values for each of the offers is selected to add to the predetermined totals.

The Office Action states that in col. 7, lines 60 to 63, Yoseloff discloses the award offers are predetermined before the display of the values, wherein the values for each of the award offers are selected to add to the predetermined totals. Applicants respectfully disagree with this interpretation of this cited passage. While Yoseloff includes the term "predetermined", this term relates to a game in which a player competes to attain predetermined combinations of symbols (i.e., winning combinations of symbols according to a payable) and not to predetermined award offers. That is, neither Yoseloff nor LMD individually, nor the gaming device resulting from the combination of Yoseloff and LMD teach, disclose or suggest award offers that are predetermined before the display of the values. On the other hand, the gaming device of amended independent Claim 46 includes award offers that are predetermined before the display of the values. Accordingly, for these reasons, Applicants respectfully submit that amended independent Claim 46 (and dependent Claims 47 to 50 and 52 to 56 which depend directly or indirectly from Claim 46) are patentably distinguished over Yoseloff and LMD and in condition for allowance.

Amended independent Claim 57 is directed to a gaming device including, amongst other elements, at least two potential award offers each formed from a plurality of values selected from a plurality of value levels displayed to a player, wherein different value levels are weighted so that at least one value level is selected more often to form the potential offers than at least one other value level.

The Office Action states that it is well known in the art to weight values within ranges in order to have certain values chosen more than others and have awards to have approximately the same expected value. The Office Action concludes that it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff's gaming device and having ranges weighted differently in order to offer the possibility to win from a wide range of awards and control the odds of the awards.

Applicants respectfully disagree and submit that neither Yoseloff nor LMD individually, nor the gaming device resulting from the combination of Yoseloff and LMD teach, disclose or suggest at least two potential award offers each formed from a plurality of values selected from a plurality of value levels displayed to a player, wherein different value levels are weighted so that at least one value level is selected more often to form the potential offers than at least one other value level. On the other hand, the gaming device of amended independent Claim 57 includes at least two potential award offers each formed from a plurality of values selected from a plurality of value levels displayed to a player, wherein different value levels are weighted so that at least one value level is selected more often to form the potential offers than at least one other value level. Accordingly, for these reasons, Applicants respectfully submit that amended independent Claim 57 (and dependent Claims 58 to 62 and 64 to 68 which depend directly or indirectly from Claim 57) are patentably distinguished over Yoseloff and LMD and in condition for allowance.

Amended independent Claim 70 is directed to a method of operating a gaming device including, amongst other elements, forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group.

Applicants respectfully submit that neither Yoseloff nor LMD individually, nor the gaming device resulting from the combination of Yoseloff and LMD teach, disclose or suggest forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the

group. On the other hand, the method of operating a gaming device of amended independent Claim 70 includes forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group. Accordingly, for this reason, Applicants respectfully submit that amended independent Claim 70 (and dependent Claims 71 to 78 which depend directly or indirectly from Claim 70) are patentably distinguished over Yoseloff and LMD and in condition for allowance.

The Office Action rejected Claims 13, 14, 29, 30, 41, 42, 50, 51, 62, 63, 78 and 79 under 35 U.S.C. §102(a) as being unpatentable over Yoseloff in view of LMD and in further view of U.S. Patent No. 5,816,918 to Kelly et al. ("Kelly").

As stated in the Office Action, Kelly discloses a gaming device connected to a network and the internet. The Office Action concludes that it would have been obvious to one skilled in the art at the time the invention was made to modify Yoseloff's and LMD's gaming device and control the gaming device through a data network and the internet, in order to allow players to play from a remote server, thus providing more flexibility when updating and monitoring the game. Applicants respectfully submit that regardless of it would have been obvious to modify Yoseloff and LMD to include the network of Kelly, regarding Claims 13, 14, 29, 30, 41 and 42, neither Yoseloff, LMD and Kelly individually, nor the gaming device resulting from the combination of Yoseloff, LMD and Kelly teach, disclose or suggest a first potential award offer formed from a first number of first values and a second potential award offer formed from a second number of second values, wherein the first number is, on average, greater than the second number, and the second values are, on average, greater than the first values. On the other hand, the gaming devices of Claims 13, 14, 29, 30, 41 and 42 each include, amongst other elements, a first potential award offer formed from a first number of first values and a second potential award offer formed from a second number of second values, wherein the first number is, on average, greater than the second number, and the second values are, on average, greater than the first values.

Applicants also respectfully submit that regardless of it would have been obvious to modify Yoseloff and LMD to include the network of Kelly, neither Yoseloff, LMD and Kelly individually, nor the gaming device resulting from the combination of Yoseloff, LMD and Kelly teach, disclose or suggest award offers that are predetermined before the display of the values. On the other hand, the gaming devices of Claims 50 and 51 each include, amongst other elements, award offers that are predetermined before the display of the values.

Additionally, Applicants respectfully submit that regardless of it would have been obvious to modify Yoseloff and LMD to include the network of Kelly, neither Yoseloff, LMD and Kelly individually, nor the gaming device resulting from the combination of Yoseloff, LMD and Kelly teach, disclose or suggest at least two potential award offers each formed from a plurality of values selected from a plurality of value levels displayed to a player, wherein different value levels are weighted so that at least one value level is selected more often to form the potential offers than at least one other value level. On the other hand, the gaming devices of Claims 62 and 63 each include, amongst other elements, at least two potential award offers each formed from a plurality of values selected from a plurality of value levels displayed to a player, wherein different value levels are weighted so that at least one value level is selected more often to form the potential offers than at least one other value level.

Moreover, Applicants respectfully submit that regardless of it would have been obvious to modify Yoseloff and LMD to include the network of Kelly, neither Yoseloff, LMD and Kelly individually, nor the method of operating a gaming device resulting from the combination of Yoseloff, LMD and Kelly teach, disclose or suggest forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group. On the other hand, the methods of operating a gaming device of Claims 78 and 79 includes forming different groups of values and forming a first offer by sequentially determining in the groups whether or not to include one of more values from the groups in the first offer until determining in each group not to include one of the values in the group.

Accordingly, for these reasons, Applicants respectfully submits that Claims 13, 14, 29, 30, 41, 42, 50, 51, 62, 63, 78 and 79 are patentably distinguished over Yoseloff, LMD and Kelly and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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